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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,557	08/16/2000	Brydon L. Bennett	860098.436	6892
7590 10/16/2003 PENNIE & EDMONDS, LLP 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036-2711			EXAMINER WRIGHT, SONYA N	
			ART UNIT 1626	PAPER NUMBER

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/642,557	BENNETT ET AL.	
	Examiner	Art Unit	
	Sonya Wright	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 24-46 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-8,25,26 and 30-32 is/are allowed.
- 6) ☒ Claim(s) 24,28,33-36 and 40 is/are rejected.
- 7) ☒ Claim(s) 3,27,29,37,38 and 41-46 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This is a response to Applicant's amendments filed 8-4-03. Claims 9 and 17-23 have been cancelled. Claims 40-46 have been added. Claims 1-8, and 24-46 are pending in this application.

The rejection under 35 U.S.C. 102 has been maintained. The rejection under 35 U.S.C. 112 of claim 9 is overcome with Applicant's amendment. The rejection under 35 U.S.C. 112 of claim 39 is withdrawn in view of Applicant's arguments. Claim 39 has been restricted out for the reason below.

Regarding claim 39, Applicant argues that the composition of claim 39 comprises both Compound 1 and JNK. Applicant argues that the claimed composition is "useful in vivo for treating a condition such as cancer, etc. . . and that the claimed composition is useful in vitro as a diagnostic standard relative to which the JNK-inhibiting potency of a variety of drug candidates can be measured". In view of Applicant's arguments, the rejection of claim 39 under 112 has been withdrawn and claim 39 has been restricted out due to the classification of JNK. Compositions containing JNK, an enzyme, are classified in class 424 and subclass 94.1+, and the instant compounds are classified in class 548 and subclass 356.5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 28, 33-36 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by STN International® CAPLUS Database, Accession No. 1989:185177, Showalter et al..

Applicant claims a composition containing an anthra[1,9-cd]pyrazol-6(2H)-one compound in claims 24, 34, 35, and 36, and a method for treating cancer in claims 28, 33, and 40.

Showalter et al. teach an anthra[1,9-cd]pyrazol-6(2H)-one compound which is useful as an anticancer agent (See Showalter CAS ONLINE abstract). Showalter et al. teach that compositions of the compound may be prepared since the compound of Showalter et al. has a pharmaceutical use, e.g. use as an anticancer agent.

Claim Objections

Claim 3 is objected to because of the following informalities: Claim 3 contains subject matter that is outside of the scope of the embodiment identified for examination in the Office Action mailed 7-16-02. It is suggested that Applicant delete "R3 and R4 taken together represent alkylidene or a heteroatom-containing alkylidene" to overcome this objection.

Claim 27 contains subject matter that is outside of the scope of the embodiment identified for examination in the Office Action mailed 7-16-02. It is suggested that claim 27 be limited to subject matter within the scope of the embodiment identified for examination, i.e. the subject matter of claim 1. Appropriate correction is required.

Claims 43-46 are missing periods at the end of each claim. It is requested that Applicant insert periods at the end of claims 43-46.

Claims 29, 37, 38, 41 and 42 are objected to as being dependent upon a rejected base claim.

Allowable Subject Matter

Claims 1, 2, 4-8, 25, 26, 30, 31, 32, are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed 8-4-03 have been fully considered and have been found persuasive with respect to the rejections under 35 U.S.C. 112, however, they are not persuasive with regard to the rejection under 35 U.S.C. 102. Applicants argue that it is inappropriate to rely on the Showalter Abstract, and not its full underlying publication, as prior art. Applicant further argues that the Showalter Abstract does not disclose, expressly or inherently, any pharmaceutical composition, much less a pharmaceutically acceptable carrier, less still a composition comprising Compound 1.

However, it is proper to use an abstract in a prior art rejection (MPEP 706.02). Even though an anthra[1,9-cd]pyrazol-6(2H)-one compound does not appear in the publication, it is proper to use the CAS ONLINE abstract in a prior art rejection, because the CAS ONLINE abstract contains an anthra[1,9-cd]pyrazol-6(2H)-one compound. The anthra[1,9-cd]pyrazol-6(2H)-one compound in the CAS ONLINE display of the abstract anticipates the instant claims. Therefore the 102 rejection is maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

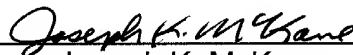
When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the

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applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

October 9, 2003